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22-06



CASE :PH7167 DIV1

FILING BY "EXPRESS MAIL" UNDER 37 CFR 1.10

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September 21, 2006  
Date of Deposit

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

IN RE APPLICATION OF  
**JOHN DUNCIA, ET AL**  
APPLICATION NO: 10/635946  
PATENT NO: 6,984,651  
FILED: 08/07/2003  
FOR: **PIPERIDINE AMIDES AS MODULATORS OF CHEMOKINE RECEPTOR  
ACTIVITY**

ART UNIT: 1625  
EXAMINER: **CHANG, CELIA C**

Commissioner for Patents  
P.O. Box 1450  
Alexandria, VA 22313-1450

REQUEST FOR RECONSIDERATION ON PETITION  
TO CORRECT PATENT TERM ADJUSTMENT

Sir:

This is a request for reconsideration of the Decision on Patent Term Adjustment issued in the above identified patent. The petition for patent term adjustment submitted on March 8, 2006 was dismissed. Applicants had requested that an Applicant delay of 120 days based on a Miscellaneous Incoming Letter be removed for the Patent Term Adjustment History.

The Request for Patent Term Adjustment was based on a "Letter to the File" which was submitted to the USPTO after the payment of the Issue Fee. The Letter to the File contained a reference which was cited in an EP communication dated May 18, 2005 in a corresponding application and was received at Bristol Myers Squibb Co. after the payment of the Issue Fee in the instant patent. The Issue Fee in the instant patent was paid on May 19, 2005. Applicants were charged with 120 days of delay based on the submission of the "Letter to the File".

The rules do not allow for the submission of an Information Disclosure Statement after the payment of the issue fee. There is no mechanism by which an Applicant can request consideration of a reference after payment of the issue fee without withdrawing the application from issue.

It is respectfully submitted that the submission of a "Letter to the File" along with the reference did not require any action on the part of the PTO other than placing the letter in the file. In the instant patent, the reference could not have been cited on in an Information Disclosure Statement as the Issue Fee had already been paid. Accordingly, the PTO could not have considered the reference attached to the "Letter to the File." The "Letter to the File" was submitted to make a record in the file of the cited reference, but not for consideration by the PTO. Therefore, the submission of the "Letter to the File" is not analogous to a submission of a priority document. The submission of the "Letter to the File" should not be considered a

"failure to engage in reasonable efforts" to conclude processing or examination of an application as the only action required on the part of the USPTO was to place the letter in the file.

For all of the reasons stated above and those stated in the Petition dated March 8, 2006, it is respectfully requested that Petition to Correct Patent Term Adjustment History should be adjusted to read 114 days of delay due to the USPTO after the payment of the issue fee and 0 days of delay due to Applicants after the payment of the issue fee, giving a total of 114 days of Patent Term Adjustment to Applicants.

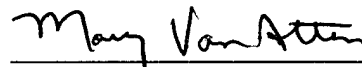
Inasmuch as Applicants believe this error is ascribable to the Patent Office, Applicant is requesting reconsideration of the patent term adjustment to 114 days. It is believed that not fees are required. However, if this is incorrect, the Commissioner is hereby authorized to charge the fees required to Deposit Account No. 19-3880 in the name of Bristol-Myers Squibb Company.

Enclosed is a copy of the "Decision on Patent Term Adjustment", dated August 21, 2006.

Respectfully submitted,

Bristol-Myers Squibb Company  
Patent Department  
P.O. Box 4000  
Princeton, NJ 08543-4000

Date: September 21, 2006



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AUG 21 2006

OFFICE OF PETITIONS

AUG 23 2006  
Docketed Item Pet Dis  
Due Date \_\_\_\_\_  
Attorney Varatter

In re Patent No. 6,984,651  
Duncia, et al.  
Issue Date: January 10, 2006  
Application No. 10/635,946  
Filed: August 7, 2003  
Attorney Docket No. PH-7167

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DECISION ON  
PATENT TERM ADJUSTMENT  
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This is a decision on the "PETITION TO CORRECT PATENT TERM PERIOD IN GENERATED PATENT UNDER 37 C.F.R. §1.181", filed March 8, 2006. Patentees request that the patent term adjustment indicated on the patent be corrected from zero (0) days to one hundred fourteen (114) days.

The application for patent term adjustment is **DISMISSED**.

On January 10, 2006, the above-identified application matured into U.S. Patent No. 6,861,091. The instant request for reconsideration filed March 8, 2006 was timely filed within two months of the date the patent issued. See §1.705(d). The Patent issued with a Patent Term Adjustment zero (0). Patentees state that they should not have been assessed applicant delay of one hundred twenty (120) days for the submission of a "Letter to File" after the Notice of Allowance.

The adjustment of one hundred twenty (120) days for the submission of a "Letter to File" after the Notice of Allowance has been determined to be correct. By Official Gazette Notice dated June 26, 2001, the Director has advised applicants and patentees that the filing of certain papers after the mailing of a Notice of Allowance will be considered a "failure to engage in reasonable efforts" to conclude processing or examination of an application and will result in reduction of a patent term adjustment pursuant to 37 C.F.R. §1.704(c)(10). See Clarification of 37 CFR 1.704(c)(10) - Reduction of Patent Term Adjustment for Certain Types of Papers Filed After a Notice of Allowance, 1247 OG 111 (June 26, 2001). A response to an examiner's reasons for allowance is listed as an example of a paper that is considered not to be a "failure to engage in reasonable efforts" to conclude processing or examination of an application. On the other hand, a certified copy of a priority document is listed as an example of a paper that is considered a "failure to engage in reasonable efforts" to conclude processing or examination of an application. In this instance the "Letter to File" transmitted a reference that was cited in an EP communication in the corresponding European Application. Accordingly, it is concluded that the "Letter to File" is more analogous to a priority document. Moreover, Applicants could have filed the "Letter to File" at anytime during prosecution of the application, but chose to wait until after the mailing of the Notice of Allowance.

In view thereof, the correct determination of PTA at the time of issuance is **zero (0)** days (1114 days of PTO delay, reduced by 153 (120+33) days of applicant delay).

The \$200 fee set forth in 37 C.F.R. §1.18(e) has been charged to Deposit Account No. 19-3880, as authorized.

Telephone inquiries specific to this matter should be directed to Cliff Congo, Petitions Attorney, at (571)272-3207.

*Kery Fries*

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Office of Patent Legal Administration  
Office of Deputy Commissioner  
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